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REMARKS

This is a full and timely response to the outstanding Advisory Action mailed September 7, 2005 and the final Office Action mailed June 15, 2005. The proposed amendments of the previous response were not entered by the Examiner, so newly proposed amendments are included in the present response. Reconsideration and allowance of the application and presently pending claims 1-2, 7-17, 21-37, 39-43, 48-59, and 63-65, as amended, are respectfully requested.

1. Claim Objection

Claim 49 has been objected to because of an informality cited in the Office Action with regard to the phrase "intended recipient's." The phrase has amended to "intended recipient's identity," as suggested in the Office Action. Therefore, Applicants respectfully request withdrawal of the objection.

2. Response to Rejection of Claim 21 Under 35 U.S.C. §112

Claim 21 has been rejected for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In response, claim 21 has been amended to overcome the rejection, and Applicants respectfully request withdrawal of the rejection.

3. Response to Rejection of Claims 1-2, 5-6, 8-10, 13-21, 25-37, 40-43, 46-48, 54-56, 58-62, and 64-65 Under 35 U.S.C. §102

In the Office Action, claims 1-2, 5-6, 8-10, 13-21, 25-37, 40-43, 46-48, 54-56, 58-62, and 64-65 stand rejected under 35 U.S.C. §102(e) as allegedly being unpatentable by *Chan* (U.S. Patent No. 6,378,070). For a proper rejection of a claim under 35 U.S.C. Section 102, the cited reference must disclose all elements/features/steps of the claim. *See, e.g., E.I. du Pont de Nemours & Co. v. Phillips Petroleum Co.*, 849 F.2d 1430, 7 USPQ2d 1129 (Fed. Cir. 1988).

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a. Claims 1-2, 8-10 and 13-17

Applicants respectfully submit that independent claim 1 is allowable for at least the reason that *Chan* does not disclose, teach, or suggest the feature of "receiving and securely retaining a transmitted document at the printout station," as recited in claim 1.

Chan is apparently limited to at most a system wherein "the secure printing process forwards across the network 110, to the document store 130, a message comprising the encrypted document. . . . [T]he document store 130 receives the message and stores it appropriately to hard disk 135." Col. 6, lines 48-54. Therefore, *Chan* fails to teach or suggest the step of "receiving and securely retaining a transmitted document at the printout station," as recited in claim 1, since the document store is not co-located with a printer in *Chan*. (Emphasis added). Thus, *Chan* does not anticipate claim 1, and the rejection should be withdrawn.

In support of the rejection, the Advisory Action states that the "fact that *Chan* may have a document store at a different location than the printout station does not preclude the printout station from receiving and securely retaining a transmitted document." However, the printer 140 in *Chan* is not equipped to securely retain a document. For example, *Chan* states that "the document store 130 returns to the printer 140 only the envelope for the document having the matching identity. In principle, the document could be sent at this stage as well, although whether or not this is done depends on the size of the document and the amount of available printer buffer memory. It is believed preferable at present to retrieve only the envelope, unless the printer 140 has a significant amount of RAM 240 into which the whole document could be received," where RAM 240 is identified as printer buffer memory. Col. 7, lines 21-29. As such, regardless, if the whole document is received in printer buffer memory, *Chan* still only provides temporary storage [via the printer buffer memory] of the document and does not "securely retain[] a transmitted document," as described in claim 1. Accordingly, *Chan* seems to clearly not teach or suggest "receiving and securely retaining a transmitted document at the printout station," and therefore *Chan* does not anticipate claim 1 for at least this reason.

Further, *Chan* fails to teach or suggest "releasing the document when the intended recipient has proved their identity by use of a second token that is uniquely related to the first token, wherein the retaining step comprises printing out the document as received and placing it in a locked compartment and the releasing step comprises a controller unlocking the compartment where the printed copy of the document is stored," as recited

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in claim 1. (Emphasis added). Moreover, the additional cited art of record also fails to disclose this feature and remedy the deficiencies of the *Chan* reference. For example, *Lundblad* seems to disclose at most a device that gathers and bundles printed sheets in a locked drawer that may be opened by anyone who is a holder of a physical key to the lock on the drawer. See col. 3, lines 3-12. As such, *Lundblad* does not teach or suggest "releasing the document when the intended recipient has proved their identity by use of a second token that is uniquely related to the first token, wherein . . . the releasing step comprises a controller unlocking the compartment where the printed copy of the document is stored." (Emphasis added). For at least this reason, *Chan* does not anticipate claim 1.

Because independent claim 1 is allowable over the cited art of record, dependent claims 2, 8-10, and 13-17 (which depend from independent claim 1) are allowable as a matter of law for at least the reason that these dependent claims contain all features/steps of independent claim 1. See, e.g., *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988). Accordingly, the rejection to these dependent claims should be withdrawn.

b. Claims 5-6 and 18-20

Claims 5-6 and 18-20 are canceled without prejudice, waiver, or disclaimer, and therefore, the rejection to these claims are rendered moot. Applicants take this action merely to reduce the number of disputed issues and to facilitate early allowance and issuance of other claims in the present application. Applicants reserve the right to pursue the subject matter of these canceled claims in a continuing application, if Applicants so choose, and do not intend to dedicate any of the canceled subject matter to the public.

c. Claims 21 and 25-37

Applicants respectfully submit that independent claim 21 is allowable for at least the reason that *Chan* does not disclose, teach, or suggest the feature of "receiving and securely retaining the digital document, the encrypted session key and an independently verifiable data record of the intended recipient at a printout station," as recited in claim 21. Thus, *Chan* fails to anticipate claim 21 for at least this reason, as has been generally discussed with regard to claim 1 previously.

Further, *Chan* does not teach or suggest "wherein . . . the requesting step comprises requesting proof of each of the intended recipients' identities at the printout station using

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data in the independently verifiable data records of the intended recipients; and the processing step comprises processing each of the intended recipients' response to the request and releasing the document when all of the intended recipients have proved their identity by use of respective second tokens that are each uniquely related to respective ones of the first tokens," as recited in claim 21. (Emphasis added). Thus, *Chan* does not anticipate claim 21, and the rejection should be withdrawn.

Because independent claim 21 is allowable over the cited art of record, dependent claims 25-37 (which depend from independent claim 21) are allowable as a matter of law for at least the reason that these dependent claims contain all features/steps of independent claim 21. Accordingly, the rejection to these dependent claims should be withdrawn.

d. Claim 40

Applicants respectfully submit that independent claim 40 is allowable for at least the reason that *Chan* does not disclose, teach, or suggest the feature of "receiving and securely retaining a transmitted document at the printout station," as recited in claim 40 and previously discussed with regard to claim 1.

Further, *Chan* does not teach or suggest "requesting proof of each of the intended recipient's identities at the printout station using data in the independently verifiable data records of the intended recipients; and processing each of the intended recipients' responses to the request for proof and releasing the document when all of the intended recipients have proved their identity by use of respective record tokens that are each uniquely related to respective-ones of the first tokens," as recited in claim 40.

Thus, *Chan* does not anticipate claim 40, and the rejection should be withdrawn.

e. Claims 41-43 and 48

Applicants respectfully submit that independent claim 41 is allowable for at least the reason that *Chan* does not disclose, teach, or suggest "one or more lockable compartments and the device is arranged to print out the document as received and place it in one of the compartments, wherein the controller is arranged to release the locked compartment containing the document, once the intended recipient has proved their identity," where the "controller [is] for releasing the document when the intended recipient has proved their identity by use of a second token that is uniquely related to the first token," as recited in

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claim 41. Thus, *Chan* does not anticipate claim 41, and the rejection should be withdrawn for at least this reason, as has been generally discussed with regard to claim 1 previously.

Because independent claim 41 is allowable over the cited art of record, dependent claims 42-43 and 48 (which depend from independent claim 41) are allowable as a matter of law for at least the reason that these dependent claims contain all features/elements of independent claim 41. Accordingly, the rejection to these dependent claims should be withdrawn.

f. Claims 46-47

Claims 46-47 are canceled without prejudice, waiver, or disclaimer, and therefore, the rejection to these claims are rendered moot. Applicants take this action merely to reduce the number of disputed issues and to facilitate early allowance and issuance of other claims in the present application. Applicants reserve the right to pursue the subject matter of these canceled claims in a continuing application, if Applicants so choose, and do not intend to dedicate any of the canceled subject matter to the public.

g. Claims 54-56 and 58-59

Applicants respectfully submit that independent claim 54 is allowable for at least the reason that *Chan* does not disclose, teach, or suggest the feature of "receiving and securely retaining the transmitted document and receiving the data record at the second station," as recited in claim 54. Therefore, *Chan* fails to anticipate claim 54 for at least this reason, as has been generally discussed with regard to claim 1 previously.

In addition, Applicants respectfully submit that independent claim 54 is allowable for at least the reason that *Chan* does not disclose, teach, or suggest the feature of "determining prior to transmission of the document whether the second station is one which is arranged to implement the present method," as recited in claim 54. Thus, *Chan* does not anticipate claim 54, and the rejection should be withdrawn for at least this reason.

Because independent claim 54 is allowable over the cited art of record, dependent claims 55-56 and 58-59 (which depend from independent claim 54) are allowable as a matter of law for at least the reason that these dependent claims contain all features/steps of independent claim 54. Accordingly, the rejection to these dependent claims should be withdrawn.

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h. Claims 60-62

Claims 60-62 are canceled without prejudice, waiver, or disclaimer, and therefore, the rejection to these claims are rendered moot. Applicants take this action merely to reduce the number of disputed issues and to facilitate early allowance and issuance of other claims in the present application. Applicants reserve the right to pursue the subject matter of these canceled claims in a continuing application, if Applicants so choose, and do not intend to dedicate any of the canceled subject matter to the public.

i. Claims 64-65

Applicants respectfully submit that independent claim 64 is allowable for at least the reason that *Chan* does not disclose, teach, or suggest the features of "communicating to the printout station and securely retaining the encrypted digital document at the printout station," as recited in claim 64. Thus, *Chan* does not anticipate claim 64, and the rejection should be withdrawn for at least this reason, as generally discussed with regard to claim 1 previously. Further, since claim 65 depends from independent claim 64, claim 65 is also not anticipated by *Chan* for at least this reason. Accordingly, the rejection to this claim should also be withdrawn.

4. Response to Rejection of Claims 3-4, 7, 11-12, 22-24, 38-39, 44-45, 49-53, 57, and 63 Under 35 U.S.C. §103

In the Office Action, claim 7 stands rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over *Chan* in view of *Menezes* (Handbook of Applied Cryptography). Claims 11-12, 38-39, 57, and 63 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over *Chan* in view of *Schneier* (Applied Cryptography). Claims 3-4, 22-24, 44-45, and 49-53 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over *Chan* in view of *Lundblad* (EP Patent Publication No. 0542703 A1).

All of the claimed features of independent claims 1, 21, 41, 49, 54, and 60 are not taught and suggested by *Chan*, as previously discussed. Further, the cited art of *Menezes*, *Schneier*, and *Lundblad* fails to cure the deficiencies of the *Chan* reference in suggesting or teaching all of the claimed features in claims 7, 11-12, 22-24, 39, 49-53, 57, and 63 (which depend from respective independent claims 1, 21, 41, 49, 54, and 60). Therefore, a *prima facie* case establishing an obviousness rejection by the proposed combination of *Chan*

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with the cited art has not been made. Therefore, the rejections of claims 7, 11-12, 22-24, 39, 49-53, 57, and 63 should be withdrawn.

Claims 3-4, 38, and 44-45 are canceled without prejudice, waiver, or disclaimer, and therefore, the rejection to these claims are rendered moot. Applicants take this action merely to reduce the number of disputed issues and to facilitate early allowance and issuance of other claims in the present application. Applicants reserve the right to pursue the subject matter of these canceled claims in a continuing application, if Applicants so choose, and do not intend to dedicate any of the canceled subject matter to the public.

5. Response to Rejection of Claims 1-2, 5-11, 13-18, 41-43, 46-48, 54-56, 58, and 60-62 Under 35 U.S.C. §102

In the Office Action, claims 1-2, 5-11, 13-18, 41-43, 46-48, 54-56, 58, and 60-62 stand rejected under 35 U.S.C. §102(b) as allegedly being unpatentable by *Mandelbaum* (EP Pat. Pub. No. 0671830A2). For a proper rejection of a claim under 35 U.S.C. Section 102, the cited reference must disclose all elements/features/steps of the claim. *See, e.g., E.I. du Pont de Nemours & Co. v. Phillips Petroleum Co.*, 849 F.2d 1430, 7 USPQ2d 1129 (Fed. Cir. 1988).

a. Claims 1-2, 5-11, and 13-18

Applicants respectfully submit that independent claim 1 is allowable for at least the reason that *Mandelbaum* does not disclose, teach, or suggest at least "wherein the retaining step comprises printing out the document as received and placing it in a locked compartment and the releasing step comprises a controller unlocking the compartment where the printed copy of the document is stored," as recited in claim 1.

Mandelbaum is apparently limited to at most a system for controlling the printing of documents at a facsimile apparatus and does not suggest or teach an approach for controlling access to printed documents. Thus, *Mandelbaum* does not anticipate claim 1, and the rejection should be withdrawn.

Because independent claim 1 is allowable over the cited art of record, dependent claims 2, 7-11 and 13-17 (which depend from independent claim 1) are allowable as a matter of law for at least the reason that these dependent claims 2, 7-11, and 13-17 contain all features/elements of independent claim 1. Accordingly, the rejection to these dependent claims should be withdrawn.

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Please note that claims 5-6 and 18 are canceled without prejudice, waiver, or disclaimer, and therefore, the rejection to these claims are rendered moot. Applicants take this action merely to reduce the number of disputed issues and to facilitate early allowance and issuance of other claims in the present application. Applicants reserve the right to pursue the subject matter of these canceled claims in a continuing application, if Applicants so choose, and do not intend to dedicate any of the canceled subject matter to the public.

b. Claims 41-43 and 48

Applicants respectfully submit that independent claim 41 is allowable for at least the reason that *Mandelbaum* does not disclose, teach, or suggest "one or more lockable compartments and the device is arranged to print out the document as received and place it in one of the compartments, wherein the controller is arranged to release the locked compartment containing the document, once the intended recipient has proved their identity," as recited in claim 41. Therefore, *Mandelbaum* does not anticipate claim 41 for at least this reason, as generally discussed with regard to claim 1 previously.

Because independent claim 41 is allowable over the cited art of record, dependent claims 42-43 and 48 (which depend from independent claim 41) are allowable as a matter of law for at least the reason that these dependent claims contain all features/elements of independent claim 41. Accordingly, the rejection to these dependent claims should be withdrawn.

Please note that claims 46-47 are canceled without prejudice, waiver, or disclaimer, and therefore, the rejection to these claims are rendered moot. Applicants take this action merely to reduce the number of disputed issues and to facilitate early allowance and issuance of other claims in the present application. Applicants reserve the right to pursue the subject matter of these canceled claims in a continuing application, if Applicants so choose, and do not intend to dedicate any of the canceled subject matter to the public.

c. Claims 54-56, 58, and 60-62

Applicants respectfully submit that independent claims 54 is allowable for at least the reason that *Mandelbaum* does not disclose, teach, or suggest "determining prior to transmission of the document whether the second station is one which is arranged to implement the present method," as recited in claim 54. For example, the portion of *Mandelbaum* cited in the Office Action as support for disclosing this feature seems to

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describe an operation of a sender displaying address book information at a sending facsimile machine. *See* col. 5, lines 5-11. Therefore, *Mandelbaum* does not anticipate claim 54 and the rejections should be withdrawn for at least this reason.

Because independent claim 54 is allowable over the cited art of record, dependent claims 55-56 and 58 (which depend from independent claim 54) are allowable as a matter of law for at least the reason that these dependent claims contain all features/elements of their respective independent base claim. Accordingly, the rejection to these dependent claims should be withdrawn.

Please note that claims 60-62 are canceled without prejudice, waiver, or disclaimer, and therefore, the rejection to these claims are rendered moot. Applicants take this action merely to reduce the number of disputed issues and to facilitate early allowance and issuance of other claims in the present application. Applicants reserve the right to pursue the subject matter of these canceled claims in a continuing application, if Applicants so choose, and do not intend to dedicate any of the canceled subject matter to the public.

6. Response to Rejection of Claims 3-4, 12, 19-40, 44-45, 49-53, 57, 59, and 63 Under 35 U.S.C. §103

In the Office Action, claims 3-4, 44-45, and 49-53 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over *Mandelbaum* in view of *Lundblad*. Claims 12, 40, 57, and 63 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over *Mandelbaum* in view of *Schneier*. Claims 19-37 and 59 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over *Mandelbaum* in view of *Auerbach* (EP Patent Publication No. 0798892 A2). Claims 38 and 39 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over *Mandelbaum* in view of *Auerbach* in view of *Schneier*.

All of the claimed features of independent claims 1, 21, 40, 41, 49, and 54 are not taught and suggested by *Mandelbaum*, for at least the reasons previously discussed. Further, the cited art of *Lundblad*, *Schneier*, and *Auerbach* fails to cure the deficiencies of the *Mandelbaum* reference in suggesting or teaching all of the claimed features of the independent claims and their respective dependent claims also. Therefore, a *prima facie* case establishing an obviousness rejection by the proposed combination of *Mandelbaum* with the cited art has not been made. Therefore, the rejections of claims 12, 21-37, 39-40, 49-53, 57, 59, and 63 should be withdrawn.

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Please note that claims 3-4, 19-20, 38, and 44-45 are canceled without prejudice, waiver, or disclaimer, and therefore, the rejection to these claims are rendered moot. Applicants take this action merely to reduce the number of disputed issues and to facilitate early allowance and issuance of other claims in the present application. Applicants reserve the right to pursue the subject matter of these canceled claims in a continuing application, if Applicants so choose, and do not intend to dedicate any of the canceled subject matter to the public.

CONCLUSION

For at least the reasons set forth above, Applicants respectfully submit that all objections and/or rejections have been traversed, rendered moot, and/or accommodated, and that the pending claims are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned agent at (770) 933-9500.

Respectfully submitted,


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